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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/537,123	10/25/2005	Gert Joly	L0006/US	8388

30522 7590 12/14/2009
KRATON POLYMERS U.S. LLC
16400 Park Row
HOUSTON, TX 77084

EXAMINER

EGWIM, KELECHI CHIDI

ART UNIT	PAPER NUMBER
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1796

NOTIFICATION DATE	DELIVERY MODE
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12/14/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

kratonip@kraton.com

Office Action Summary	Application No. 10/537,123	Applicant(s) JOLY ET AL.	
	Examiner Dr. Kelechi C. Egwim	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 October 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-16 and 18-33 is/are pending in the application.
- 4a) Of the above claim(s) 22-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-16 and 18-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>09/24/2009</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/08/2009 has been entered.

2. Due to amendments and persuasive arguments by applicant, the previous rejections based on Ouhadi have been overcome and are hereby withdrawn.

Claim Rejections - 35 USC § 102/ 103

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 11-16 and 18-21 are rejected under 35 U.S.C. 102(b) as being anticipated by or, in the alternative, 35 U.S.C. 103(a) as being unpatentable over Zhang et al., for reason cited in previous actions.

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5. Claims 11-16 and 18-21 are rejected under 35 U.S.C. 102(a or e) as being anticipated by or, in the alternative, 35 U.S.C. 103(a) as being unpatentable over Varma, for reason cited in previous actions.

6. Claims 11-16 and 18-21 are rejected under 35 U.S.C. 102(b) as being anticipated by or, in the alternative, 35 U.S.C. 103(a) as being unpatentable over Maekawa et al. (USPN 6,096,435).

In col. 3, lines 32-40, col. 5, line 60-63, col. 17-47 and col. 9, lines 47 -68, Maekawa et al. teach compositions comprising a blend of an A-B-A styrenic-isoprene/butadiene-styrenic block copolymer, within the claimed molecular weights and ratios, and a second polyolefinic thermoplastic resin.

While Maekawa et al. do not test the Tg's their diene blocks, it is reasonable that the diene blocks in the block copolymers of the prior art would possess the presently claimed properties since the composition of the prior art block copolymers are essentially the same as the claimed composition and the USPTO does not have at its disposal the tools or facilities deemed necessary to make physical determinations of the sort. In any event, an otherwise old composition is not patentable regardless of any new or unexpected properties. In re Fitzgerald et al, 619 F.2d 67, 205 USPQ 594 (CCPA 1980). See MPEP § 2112 - § 2112.02.

Even if assuming that the prior art references do not meet the requirements of 35 U.S.C. 102, it would still have been obvious to one of ordinary skill in the art, at the time the invention was made, to arrive at the same inventive composition because the

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disclosure of the inventive subject matter appears within the generic disclosure of the prior art.

Further, one of ordinary skill in the art would have found it prima facie obvious to determine a workable or even optimal Tg range for the diene center blocks, based on the final application. "[D]iscovery of an optimum value of a result effective variable in a known process is ordinarily within the skill of the art." In re Boesch, 617 F.2d 272,276, 205 USPQ 215, 219 (CCPA 1980); "[W]here the general conditions of a claim are disclosed in the art, it is not inventive to discover the optimum or workable ranges by routine experimentation. In re Aller, 220 F.2d 454,456, 105 USPQ 233, 235 (CCPA 1955).

Response to Arguments

7. Applicant's arguments filed 10/08/2009 have been considered but they are not fully persuasive.

8. Applicant admits that Zhang et al. and Varma "suggest an SBC [styrenic block copolymer] with the structure S-I/B-S" but argues that "the Examiner has not shown that the prior art is similar to Applicant's invention". This is inconsistent. The examiner has conceded that the prior art do not make the same Tg measurements as applicant. However, the consistency in the structure of the prior art styrenic block copolymer with that of the present claims, i.e., the structure S-I/B-S, including molecular weight, is sufficient similarity to at least suggest a similarity in properties, including Tg.

If applicant is relying on other structural difference to distinguish their copolymer from the styrenic block copolymer of the prior art, applicant must claim said differences, otherwise they are not considered in the claim analysis.

9. Nonetheless, it is still applicant burden to demonstrate that the prior art copolymers with the claimed structural characteristics, within the claimed ranges, do not met applicant claims properties characteristics/measurements.

10. In response to applicant's argument that the focus of the prior art differ form tha recited in the present application, such an argument must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Kelechi C. Egwim whose telephone number is (571) 272-1099. The examiner can normally be reached on M-T (7:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dr. Kelechi C. Egwim/
Primary Examiner, Art Unit 1796

KCE